

REMARKS

The application has been amended and is believed to be in condition for allowance. The instant paper is submitted as part of a Request for Continued Examination (RCE).

Amendments to the Disclosure

Claim 1 is amended to overcome the Official Action's objection, as further detailed below.

Independent claims 1, and 21-23 are amended to expressly recite the remainder portion of the inventive card in order to more clearly distinguish over the prior art. The amendments find support in the specification and the drawing figures as originally filed (e.g., page 3, lines 1-9; page 4, lines 7-10; Figures 1-3 at element 12) and do not introduce new matter.

Formal Issues - Claim Objections

The Official Action objected to claims 4, 7, 8, and 14 based on antecedent basis issues.

In reply, claims 4, 7, 8 and 14 are amended responsive to the Official Action's objections. Withdrawal of the objections to the claims is thereby earnestly solicited.

Substantive Issues - Section 102

The Official Action rejected claims 1, 7-8, 10, and 12-13 under 35 USC 102(b) as being anticipated by Nishikawa et al. (US 5,581,065; "NISHIKAWA").

In response, it is firstly noted that independent claim 1 has been amended to recite a card body comprised of a microcircuit card precut in the card body, a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body, and a remainder portion of the card body removably connected to both the microcircuit card and the token. It is respectfully submitted that none of the aforementioned references, as applied by the Official Action, teach or suggest the structure as recited.

The Official Action offers Figure 47B of NIKISHAWA as teaching an 1D-000 format microcircuit card precut in an 1D-1 format card body, citing elements 41 and 43, respectively, wherein the format card body would disclose the token as recited by the invention.

However, the invention as recited by claim 1 recites a remainder portion distinctive from and removably attached to the token. Nothing in the Figure of NIKISHAWA teaches or suggests this. On the contrary, the Figure only discloses two parts: a card base 43 and an IC carrier 41 (column 1, lines 40-45).

Further, it follows that NIKISHAWA fails to teach a token precut in a card body. As is clear from the Figure, only the IC carrier 41 is shown as in another object (here, the card base 43, which completely surrounds the IC carrier 41 and itself extends completely to the outer periphery of the card 41).

In addition, it is respectfully submitted that the card body 43, as identified by the Official Action, discloses a "token" as recited in the claims. NIKISHAWA discloses IC card 40 as a carrying means "from which only IC carrier 41 is taken off to be used," (column 1, lines 43-45), the advantage being that the card body 43 as a form-factor that is already known to be in production, including inspection facilities, issue systems and sending systems (column 1, lines 46-50). As disclosed, the card body 43 of Figure 47B is discarded after the IC carrier 41 is removed (column 1, lines 43-54).

In contrast, a token as described by the instant invention is a badge carrying data to be read mechanically or magnetically, a promotional gift carrying the logo and phone number of a supplier, a utilitarian object such as a key fob, and other uses (see, e.g., specification page 2, lines 20-27). At best, NIKISHAWA describes the card body 43 as merely a substrate for the IC carrier 41, including identification markings related to the IC carrier 41 (because the IC carrier 41 is too small to contain such markings). Once the IC carrier is removed and placed into a portable phone, (e.g., column 1, lines 18-23), the remaining card body 43 with a prominent hole where the IC carrier 41 used to be does not have a purpose.

The Official Action additionally states that NIKISHAWA Figure 47B teaches a hole through a thickness of the card body 43 to receive a key-ring (as recited by claim 1), and further that

the NIKISHAWA teaches the location of this hole in a corner of the token in the vicinity of the microcircuit card (as recited by dependent claim 12), even though Figure 47B fails to disclose any such hole at any location on card body 43.

The Official Action states that it is well known in the art to add a keyhole to a corner of a card. Applicant respectfully disagrees and rebuts this statement. It is respectfully submitted that no teaching in the reference is offered to anticipate the hole as recited in claims 1 and 12, and in any case, there is absolutely no teaching or suggestion to incorporate a such a hole into the card body 43 of Figure 47B. When the card body 43 and the IC carrier 41 are attached, the inclusion of a key-ring hole would encourage the exposure of the IC carrier 41 to abuse and damage on a key-ring. In the case where the IC carrier 41 is removed, the card body 43 no longer has purpose; why would one therefore keep it on a key-ring, especially given its size?

Further, in particular to claim 12, there is no teaching or suggestion of a placement of a hole in a vicinity of the microcircuit card.

It is therefore respectfully submitted that the invention as recited in amended claim 1 is not anticipated by NIKISHAWA.

It is further respectfully submitted that the recitations of the claims depending from claim 1 are novel over NIKISHAWA at least for depending from a patentable claim.

For example, it is respectfully submitted that NIKISHAWA fails to teach claim 13, the token being connected to the remainder portion of the card body by mechanically weakened areas consisting of grooves. As indicated above, NIKISHAWA fails to teach a remainder portion distinct from a token and also distinct from a microcircuit card. Hence, claim 13 is novel over NIKISHAWA.

Withdrawal of the rejections under 35 USC 102(b) in view of NIKISHAWA is therefore respectfully solicited.

Substantive Issues - Section 103

The Official Action rejected claims 3-6, 14-15, 18 and 20-28 under 35 USC 103(a) as being unpatentable over NISHIKAWA in view of Smith et al. (US 7,065,195; "SMITH") and further in view of Pentz et al. (US 6,471,127; "PENTZ").

In response, it is respectfully submitted that claims 3-6, 14-15, 18, and 24-28 are patentable at least for depending from a patentable claim, as indicated above as to claim 1.

For example, it is respectfully submitted that none of the applied references, individually or in combination, teach or suggest a card comprised of a microcircuit card, a token, and a remainder portion as recited in claim 1, wherein the token extends to only one corner of the card body.

The Official Action concedes that NISHIKAWA fails to teach a token extending to only one corner of a card body. The Official Action offers SMITH at Figures 1A and 1B as teaching a sheet frame card carrier to carry a SIM card and a miniature telephone calling card in order to provide a multipurpose calling card with separable functional parts, wherein the sheet frame carrier extends to two corners of the card body.

Applicant respectfully disagrees. SMITH is directed to a multi-purpose calling card with a calling card portion and a key-ring portion, provided side-by-side in a card with a single cut between them provided for dividing the card into the two component parts (column 3, lines 1-12; Figures 1A-B).

In contrast to the invention as recited in independent claim 1, no remainder portion is disclosed. SMITH consists only of a two parts removably joined to form a card. Further, SMITH fails to teach a token extending to only one corner of the card body.

The Official Action concedes that SMITH makes no teaching or suggestion of its miniature card extending only to one corner of the card body. The Official Action offers PENTZ as teaching a calling card with smaller dimensions.

In response, it is firstly noted that the proposed combination of NIKISHAWA, SMITH, and PENTZ makes yet no teaching or suggestion of the remainder portion as recited by claim 1.

For example, SMITH only teaches a card in two parts, and PENTZ only brings attention to a smaller-sized card.

It is further respectfully submitted that one of skill would have had no reasonable motivation to reduce the size of SMITH's calling card portion 110 merely to cause the calling card portion 110 not to extend to a second corner of the keytag portion 120.

Applicant acknowledges that SMITH discloses that "the calling card portion 110 of the multipurpose card 100 acts as a conventional prepaid phone case... [and] may be approximately 2.25 inches wide and .125 inches high so as to be easily inserted into a wallet... [and further that] [i]t will be appreciated that other dimensions may be used," (column 3, lines 13-17). However, it is respectfully submitted that this teaching by no means suggests that the dimensions of the calling card portion 110 are arbitrary, or indeed that the assembled calling card 100 may be significantly altered from "the same size as a conventional prepaid telephone calling card (i.e., approximately 3.375 inches wide and 2.125 inches high)," (column 3, lines 1-4; see also column 4, lines 28-36).

The conventional size conforms to standards such as the card-carrying portion of a wallet, the slot for card-reading machines, and devices for the manufacture of such cards. There is no teaching in any of the applied references to suggest to one of skill to deviate from the standard dimensions of the card 100.

Further, the structure as proposed by the Official Action would yield an assembly where the keytag portion 120 extends higher than the calling card portion 110. Not only would this be unsightly, the exposed portion of the keytag portion 120 would be subject to damage, and raise the probability of an undesired separation from the calling card portion 110, especially as the card 100 is handled in and out of the slot of a wallet or machine.

The conclusion of obviousness is not sufficient merely because the references relied upon allegedly teach that substantially all aspects of the claimed invention were individually known in the art; an objective reason to combine the teachings of the references must be articulated with some rational underpinning to support the legal conclusion of obviousness. MPEP § 2143.01, paragraph IV. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR v Teleflex*, 82 USPQ2d at 1395. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984; emphasis added).

The Official Action contends that one of skill would have been motivated to modify the teachings of SMITH and



NISHIKAWA with the teachings of PENTZ in order to provide a means of packaging the miniature calling card of PENTZ with a SIM card.

However, even if one of skill were so motivated, there is no teaching or suggestion why one of skill would not pair the miniature card of PENTZ with a taller keytag portion, exposing the structure to damage as indicated above. On the contrary, one of skill would most likely have been motivated by SMITH to match the miniature card of PENTZ with a proportionally miniaturized mating keytag portion, thereby preserving the regular rectangular shape of the assembled card without superfluous exposed edges.

In other words, even with the teaching of PENTZ, one of skill would have been motivated to make a calling card portion 110 that extends to two corners of the card body.

This combination fails to teach or suggest the invention recited by claims 1 and 3, wherein the token extends to only one corner of the card body.

It is therefore respectfully submitted that claim 3 is patentable in its own right, in addition to being dependent from patentable parent claim 1.

Dependent claim 28 is also patentable in its own right for the reasons as to claim 3, in addition to being dependent from patentable parent claim 1.

Dependent claims 14 or 15 are also believed to be patentable in their own right, in addition to being dependent from a patentable parent claim, at least because none of the

applied prior art teaches or suggests to combine in a same card body, a microcircuit card and a token of the contactless type or of the RFID type, i.e. two parts able to communicate with the exterior by different ways.

It is further respectfully submitted that independent claims 21-23, as amended, are patentable for at least the same reasons as set forth above.

Reconsideration and allowance of the claims are respectfully requested.

From the foregoing, it will be apparent that Applicant has fully responded to the July 21, 2009 Official Action and that the claims as presented are patentable. In view of this, Applicant respectfully requests reconsideration of the claims, as presented, and their early passage to issue.

In order to expedite the prosecution of this case, the Examiner is invited to telephone the attorney for Applicant at the number set forth below if the Examiner is of the opinion that further discussion of this case would be helpful.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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